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09/556,276	04/24/2000	Fred S. Cook	1352	8008

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EXAMINER

ZIA, SYED

ART UNIT PAPER NUMBER

2131

DATE MAILED: 12/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/556,276

Applicant(s)

COOK, FRED S.

Examiner

Syed Zia

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 07 July 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 1-24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This is response to amendment filed on July 07, 2003 (Paper No. 4). Applicant cancelled all originally filed Claims, and added new Claims 25-40. The amendment filed have been entered and made of record. Presently pending claims are 25-40.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The analysis under 35 U.S.C. 112, first paragraph, requires that the scope of protection sought be supported by the specification disclosure. The pertinent inquiries include determining (1) whether the subject matter defined in the claims is described in the specification and (2) whether the specification disclosure as a whole is to enable one skilled in the art to make and use the claimed invention.

(1) Claims 25-31, and 33-39 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The "invention" for the purpose of the first paragraph analysis is defined by the claims. The description requirement is simply that the claimed subject matter must be described in the specification. The function of the description requirement is to ensure that the applicant had

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possession of the invention on the filing date of the application. The application need not describe the claim limitations exactly, but must be sufficiently clear for one of ordinary skill in the art to recognize that the applicant's invention encompasses the recited limitations. The description requirement is not met if the application does not expressly or inherently disclose the claimed invention.

Specification does not explicitly describe nor is sufficiently clear for one of ordinary skill in art to recognize the following steps as recited in claims 25-31, and 33-39:

- in the access server, receiving a prepaid account code from the network device to gain **access to the internet through the first access provider and wherein the prepaid account code is associated with a second access provider; transferring the prepaid account code from the access server to a local database system of the first access provider.**

- in the local database system, processing the prepaid account code **to determine if the network device is allowed to access the Internet through the first access provider**

- . if the network device is **allowed to access the Internet, providing Internet access to the network device through the first access provider.**

- . processing the prepaid account code to determine if **the network device is allowed to access the internet through the first access provider comprises comparing the prepaid account code to information stored in the local database system and determining that the prepaid account code is associated with the second access provider in the local database system and allowing the network device to access the internet through the first access provider.**

- . if the network device is **not allowed to access the Internet, transferring a decline message to the access server.**

. receiving the decline message in the access server and **appealing the decline to an appeal server including transferring the prepaid account code to the appeal server and processing the prepaid account code in the appeal server to determine if the network device is allowed access to the internet through the first access provider.**

. the prepaid account code is linked to a prepaid account and wherein the prepaid account code is displayed on a prepaid account card and wherein the second access provider provides the prepaid account card to a user and wherein the **user utilizes the network device and the prepaid account card to access the internet**

. processing the prepaid account code to determine if **the network device is allowed to access the internet is based on a remaining amount of time on a prepaid account** associated with the prepaid account code, and processing the prepaid account code to determine if the **network device is allowed to access the Internet is based on a remaining amount of money on a prepaid account associated with the prepaid account code.**

Claims 25-31, and 33-39 are unclear that the one ordinarily skilled in the art cannot recognize the encompassed claim limitations.

(2) Claims 25, 28, 33, and 36 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The enablement requirement necessitates a determination that the disclosure contains sufficient teaching regarding the subject matter claimed as to enable one skilled in the pertinent art to make and use the claimed invention. In essence, the scope of

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enablement provided to one ordinarily skilled in the art by the disclosure must be commensurate with the scope of protection sought by the claims.

Currently, the most prevalent standard for measuring sufficient enablement to meet the requirements of 112 is that of "undue experimentation". The test is whether, at the time of the invention, there was sufficient working procedure for one skilled in the art to practice the claimed invention without undue experimentation. It is important to note that the test of enablement is not whether any experimentation is necessary, but whether, if experimentation is necessary, is it undue. A skilled artisan is given sufficient direction or guidance in the disclosure. Moreover, the experimentation required, in addition to not being undue, must not require ingenuity beyond that expect of one of ordinary skill in the art.

Undue experimentation and ingenuity would be required beyond one ordinarily skilled in the art to practice the following steps as recited in claims 25, 28, 33, and 36.

· in the access server, receiving a prepaid account code from the network device to gain **access to the Internet through the first access provider and wherein the prepaid account code is associated with a second access provider; transferring the prepaid account code from the access server to a local database system of the first access provider.**

. receiving the decline message in the access server and **appealing the decline to an appeal server including transferring the prepaid account code to the appeal server and processing the prepaid account code in the appeal server to determine if the network device is allowed access to the internet through the first access provider**

Undue experimentation would be needed to make communication interface that receives a plurality of applications, which are not limited to any functionality, from an external source.

Response to Arguments

Applicant's arguments with respect to claim 25-40 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

1. The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 25-40 are rejected under 35 U.S.C. 102(e) as being anticipated by Toader et al. U. S. Patent 5,749,075.

3. Regarding Claim 25 Toader teaches a method of providing Internet access to a network device through a first access provider, the method comprising:

- in an access server, generating a logon query for a network device; transmitting the logon query from the access server to the network device, and in the access server, receiving a prepaid account code from the network device to gain access to the internet through the first access provider and wherein the prepaid account code is associated with a second access provider; transferring the prepaid account code from the access server to a local database system of the first access provider (col.3 line 6 to line 32, and col.5line 49 to col.6 line 39);

- in the local database system, processing the prepaid account code to determine if the network device is allowed to access the Internet through the first access provider (col.5 line 59 to line 65); and

- if the network device is allowed to access the Internet, providing Internet access to the network device through the first access provider (col.5 line 59 to col.6 line 7).

4. Regarding Claim 33 Toader teaches system for providing Internet access to a network device through a first access provider, the system comprising:

- an access server configured to generate a logon query for a network device, transmit the logon query from the access server to the network device, receive a prepaid account code from the network device to gain access to the internet through the first access provider wherein the prepaid account code is associated with a second access provider, and transfer the prepaid

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account code from the access server to a local database system of the first access provider (col.3 line 6 to line 32, and col.5 line 49 to col.6 line 39);

- the local database system configured to process the prepaid account code to determine if the network device is allowed to access the Internet through the first access provider (col.5 line 59 to line 65); and

- the first access provider configured to provide Internet access to the network device if the network device is allowed to access the Internet (col.5 line 59 to col.6 line 7).

5. Claims 26, 27, 29, 32, 34, 35, 37, and 40 are rejected applied as above rejecting Claims 25, and 33. Furthermore, Toader teaches and describes wherein:

- processing the prepaid account code to determine if the network device is allowed to access the internet through the first access provider comprises comparing the prepaid account code to information stored in the local database system and determining that the prepaid account code is associated with the second access provider in the local database system and allowing the network device to access the internet through the first access provider (col.5 line 49 to line 53, and col. 6 line 8 to line 32);

- if the network device is not allowed to access the Internet, transferring a decline message to the access server (col.3 line 48 to line 50);

- the prepaid account code is linked to a prepaid account and wherein the prepaid account code is displayed on a prepaid account card and wherein the second access provider provides the prepaid account card to a user and wherein the user utilizes the network device and the prepaid account card to access the Internet (col.5 line 4 to line 39);

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- the prepaid account code comprises a username and a password (col.5 line 49 to line 53);

- the local database system is configured to compare the prepaid account code to information stored in the local database system and determine that the prepaid account code is associated with the second access provider in the local database system and allow the network device to access the internet through the first access provider (col.5 line 49 to line 53, and col.6 line 8 to line 32);

- the local database system is further configured to transfer a decline message to the access server if the network device is not allowed to access the Internet through the first access provider (col.3 line 48 to line 50);

- the prepaid account code is linked to a prepaid account and wherein the prepaid account code is displayed on a prepaid account card and wherein the second access provider provides the prepaid account card to a user and wherein the user utilizes the network device and the prepaid account card to access the Internet (col.5 line 4 to line 39);

- the prepaid account code comprises a username and a password (col.5 line 49 to line 53).

6. Claims 28, 30, 31, 36, 38, and 39 are rejected applied as above rejecting Claims 27, 29, 35, and 37. Furthermore, Toader teaches and describes wherein

- receiving the decline message in the access server and appealing the decline to an appeal server including transferring the prepaid account code to the appeal server and processing the prepaid account code in the appeal server to determine if the network device is allowed access to the internet through the first access provider (col.5 line 28 to line 38);

-processing the prepaid account code to determine if the network device is allowed to access the internet is based on a remaining amount of time on a prepaid account associated with the prepaid account code, and processing the prepaid account code to determine if the network device is allowed to access the Internet is based on a remaining amount of money on a prepaid account associated with the prepaid account code (col.6 line 25 to line 39);

- the access server is further configured to receive the decline message, appeal the decline to an appeal server, and transfer the prepaid account code to the appeal server, and wherein the appeal server is configured to process the prepaid account code to determine if the network device is allowed access to the Internet through the first access provider (col.5 line 28 to line 38);

- the local database system is configured to process the prepaid account code to determine if the network device is allowed to access the internet based on a remaining amount of time on a prepaid account associated with the prepaid account code, and the local database system is configured to process the prepaid account code to determine if the network device is allowed to access the internet based on a remaining amount of money on a prepaid account associated with the prepaid account code (col.6 line 25 to line 39).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Syed Zia whose telephone number is 703-305-3881. The examiner can normally be reached on Monday - Friday 9:00 AM to 5:00 PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on 703-305-9648. The fax phone number for the organization where this application or proceeding is assigned is 703-746-7239.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-746-7240.

SZ

November 29, 2003


AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100